

Remarks

The non-final Action of May 19, 2008 has been received and carefully reviewed. In the Office Action, claims 1-18 and 21-22 are pending; claims 2 and 11 are withdrawn. Claims 1, 3-10, 12-18 and 21-22 stand rejected under 35 U.S.C. §112, first paragraph as assertedly failing to comply with the written description requirement. Claims 1, 3-9 and 21 stand rejected under 35 U.S.C. §112, second paragraph as assertedly being indefinite. All pending claims said to be free from art rejections. Reconsideration is respectfully requested.

I. Amendments to the claims.

Claim 1 is amended to remove the limitation “machined” from line 12. As discussed in more detail below in response to the rejection under 35 U.S.C. §112, ¶2, this term is believed to extraneous in light of the specified order of steps and its removal is believed to obviate the rejection. Claims 1 and 10 are also amended as discussed below with respect to the rejection under 35 U.S.C. §112, ¶1. No new matter is presented.

II. Examiner Interview.

Applicants thank the Examiner for the courtesy of an interview with the Applicants’ undersigned representative on July 30, 2008 in which the outstanding rejections were discussed and on which Applicants’ representative understood an agreement to have been reached. It is respectfully submitted that the present amendments are consistent with that agreement and that the Application should now be in condition for allowance.

III. Rejection under 35 U.S.C. §112, ¶1.

Claims 1, 3-10, 12-18 and 21-22 stand rejected under 35 U.S.C. §112, first paragraph as assertedly failing to comply with the written description requirement. Specifically, the Examiner states that the rejection stems from the alleged lack of support in the Application for the limitation “in the absence of additional heat treatment steps” added in the last response, which the Examiner asserts is not found in para. [0028] as stated by Applicants. Applicants respectfully traverse the rejection.

While the exact words “in the absence of additional heat treatment steps” were not found explicitly in the Application, Applicants respectfully submit that support for the limitation is found within the written description and that one of ordinary skill in the art would appreciate it as such. More specifically, the Application discusses the heat treatment with respect to the three specific heat treatment steps shown at reference numeral 26 in Figure 1; the Application does not require any additional heat treatment steps. Thus, Applicants respectfully submit that they can restrict the claims to exclude any such further steps. Indeed, as discussed at [0028] of the Application, provided as support for the prior amendment, it is with reference to the specific three step heat treatment shown at 26 in Figure 1 that the variation in yield strength within two specific zones to provide desirable results is discussed. Thus, it follows that the achievement of the desired results in those three step permits the final machining of the part to be achieved in the absence of any additional heat treatment steps.

Notwithstanding the foregoing, based on the Examiner interview, Applicants have proposed alternative language that excludes additional heat treatment steps between the rough and final machining steps which is presented in more conventional claim language.

IV. Rejection under 35 U.S.C. §112, ¶2.

Claims 1, 3-9 and 21 stand rejected under 35 U.S.C. §112, second paragraph as assertedly being indefinite. Specifically, the Examiner indicated that introducing the term “machined” into line 12 of claim 1 created confusion regarding the proper source of antecedent basis as it related to other limitations. While Applicants disagree that one of ordinary skill in the art would not have appreciated the invention, Applicants do agree that the “machined” limitation is extraneous because the order of steps is specified such that all three of the heat treatment steps necessarily follow the rough machining operation.

As a result, Applicants respectfully request this ground of rejection be withdrawn.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully request reconsideration of the Application and withdrawal of all outstanding rejections. Applicants request rejoinder of the withdrawn claims followed by allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

This Response has been filed within three (3) months of the mailing date of the Final Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in these calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

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Respectfully submitted,
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